



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,518	07/11/2003	Edward J. Mueller	31660-1001	6589

5179 7590 04/07/2005

PEACOCK MYERS AND ADAMS P C  
P O BOX 26927  
ALBUQUERQUE, NM 871256927

EXAMINER
----------

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/618,518	MUELLER, EDWARD J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joanne Silbermann	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*M*

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claims 26 and 63 it is not clear how the support can be both hollow and solid at the same time since these words are opposites. The drawings show a support that is hollow, therefore that is how the claims will be read.
4. In claims 33 and 66 it is not clear how an opaque support can be illuminated through said entire exterior perimeter, as required by claims 26 and 63.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 26-28, 34, 35, 38, 41, 45, 46-48, 51, 57, 58, 60, 63-68, 71, 74 and 87-89 (as far as definite) are rejected under 35 U.S.C. 102(b) as being anticipated by Howard, US #1,256,232.

Art Unit: 3611

7. Howard discloses a lighted pole and banner assembly including elongated, hollow support 1a having interior and exterior perimeters (Figures 9 and 11), light source (including at least one lighting element, an incandescent bulb, that inherently is one color) 8 disposed within the pole, and banner 2 (Figure 1). The support includes at least one translucent section 9 and other sections that are not translucent, thus providing different brightness, with the brighter section nearer the banner (Figure 1). The sections are connected together and are therefore considered to be "integral." The light source extends the length of support 1a. Power is provided from the automobile on which the display is mounted, the car battery providing a rechargeable source. The support further includes ornamental design 5. The support may include electrical cords 32 and 33 (Figure 2).

8. The methods steps of the instant claims (providing, disposing, illuminating) would inherently be followed by one skilled in the art when assembling the device of Howard.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 29, 30, 32, 33, 36, 37, 39, 40, 42-44, 49, 50 and 52-56 (as far as definite) are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard.

11. Howard does not teach the support as being completely clear, or transparent, or opaque. However, as best as the instant claims can be understood at this time, it would

Art Unit: 3611

have been obvious to one of ordinary skill in the art to vary the construction of the support pole to accommodate the degree of illumination desired.

12. Howard also does not teach using LEDs, rope lights, neon, fluorescent lights or fiber optics. These light sources are all old and well known in the art. It would have been obvious to one of ordinary skill to utilize a different light source as an alternative equivalent. It also would have been obvious to utilize a different light source so as to use less electricity and require less frequent changing of lights.

13. Howard does not teach different colors, however the particular color of the lights is considered to be entirely a matter of design choice. Matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. In re Seid, 73 USPQ 431 (CCPA 1947). It would have been obvious to a person having ordinary skill in the art to utilize any known color for the lights so as to provide the desired type of display.

14. Howard does not teach varying brightness, blinking lights or sequential lighting, however these are common. Dinner switches are well known in the art of illumination and blinking and sequential lighting are commonly used. It would have been obvious to utilize a dinner function for the light sources so that the appropriate amount of illumination may be employed. It also would have been obvious to utilize blinking or sequential lighting to attract attention to the display.

15. Howard does not specifically teach using polymeric material or acrylic, however these materials are well known in the art. It would have been obvious to one of ordinary skill to utilize these materials since it has been held to be within the general skill of a

Art Unit: 3611

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Howard in view of Taylor, US #2,509,707.

17. Howard does not teach using a luminescent support, however, this is well known in the art. Taylor teaches a hollow, luminescent support having illumination disposed within the support (Figures 1 and 2). It would have been obvious to one of ordinary skill in the art to utilize a luminescent support so as to provide a different looking display, and to provide a support that glows after the light is turned off.

18. Claims 59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard in view of Siew, US #4,833,443.

19. Howard does not teach a holder having arms, however such a holder/bracket is well known in the art. Siew teaches a bracket for mounting an illuminated display including electrical cord 15 accommodated by bracket 7 having space 11 between two arms (Figure 1). It would have been obvious to one of ordinary skill to utilize such a bracket so that the display may be mounted over a window or other thin object (as shown by Siew).

### ***Response to Arguments***

20. Applicant's arguments filed January 6, 2005 have been fully considered but they are not persuasive.

21. Applicant argues that the new claims have the limitation of an elongated solid hollow support with a light source disposed therein. As discussed above, it is confusing

Art Unit: 3611

as to how the support can be both hollow and solid at the same time. The support of Howard is hollow so that illumination may be placed inside, and it may be considered "solid" in that as a finished product it does not have any holes or openings.

22. Regarding the type of light sources, color of lights, etc. these are addressed in the above rejection. If Applicant does not feel that these are alternate equivalents, the claims will be subject to several elections of species.

### ***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 703-308-2091. The examiner can normally be reached on M-F 5:30 - 2:00.

Art Unit: 3611

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

JS